

**REMARKS**

Applicant acknowledges receipt of the Office Action mailed June 23, 2010.

The Office Action objected to claim 25. The Office Action rejected claims 20 and 21 under 35 U.S.C. § 103(a) as obvious over Nakahara et al. (U.S. Patent Publication No. 2002/0012304) in view of Ko et al. (U.S. Patent Publication No. 2006/0077843). The Office action further rejected claims 1-6, 9-14, 17-19, and 22-25 under 35 U.S.C. § 103(a) as obvious over *Nakahara* in view of *Ko* and further in view of Kikuchi et al. (U.S. Patent Publication No. 2003/0147629.) The Office Action also rejected claims 7, 8, 15, and 16 under 35 U.S.C. § 103(a) as obvious over *Nakahara* in view of *Ko* and further in view of *Kikuchi* and Shimizu et al. (Japanese Patent Document 2004-318923.)

In this reply, Applicant amends claims 1-3, 8-10, and 20-25. Claims 1-25 remain pending and under examination. The originally-filed specification, claims, abstract, and drawings fully support the amendments to the pending claims. No new matter has been added.

**I. OBJECTION**

The Office Action objected to claim 25 alleging that it contained an extra term. Applicant amends claim 25 to recite *inter alia* “[a] non-transitory computer-readable medium comprising instructions executable by a computer processor to implement a method for image recording control, the method comprising . . . updating the predetermined menu based on the additionally recorded data when the mode indicates that additional recording onto the inserted disk is allowed.”

Based on the foregoing amendment, Applicant respectfully requests favorable reconsideration and withdrawal of the objection to claim 25.

## II. 35 U.S.C. § 103(a) REJECTION

The Office Action rejects claims 1-6, 9-14, 17-19, and 22-25 under 35 U.S.C. § 103(a) as unpatentable over *Nakahara* in view of *Ko* and further in view of *Kikuchi*. The Office Action also rejects claims 7, 8, 15, and 16 under 35 U.S.C. § 103(a) as obvious over *Nakahara* in view of *Ko* and further in view of *Kikuchi* and *Shimizu*. And, the Office Action rejects claims 20 and 21 under 35 U.S.C. § 103(a) as unpatentable over *Nakahara* in view of *Ko*. Applicant respectfully traverses the rejection of these claims. Applicant amends independent claims 1, 2, 9, 20, and 22-25 to include additional features.

The Office Action alleges that *Nakahara* discloses an editing system which includes “[a] disk-determining circuit/unit for determining whether or not the loaded subject disc is a DVD + RW type disc that, by definition, includes a menu.” (*Office Action*, pg. 3.) As a preliminary matter, Applicant respectfully disagrees that a DVD + RW disc includes a menu by definition. As disclosed in the specification, a DVD + RW disc can store a menu but every DVD + RW disc need not necessarily have a menu stored on it. (See *Specification* at pg. 2 stating that “[i]n the case of the above-described DVD that can record data, *finalization is performed*, so as to generate the DVD menu and the photo movie.” Emphasis added.) Thus, if finalization is not performed, for example, no menu may be stored on a DVD disc. Further, referring to Fig. 5, the Specification also discloses that “the existence of the DVD menu can be determined by checking whether or not the VMGM\_VOBS 732 exists in the VMG 730. (See *Specification* at pg. 25.) Thus, not every DVD disc includes a menu by definition.

*Nakahara* appears to disclose a device which detects the type of disk “[o]n the basis of the information obtained from the [lead-in] area” by irradiating the lead-in area

of the loaded optical disk with a light beam. (*Nakahara*, pg. 6, para. 0124.) *Nakahara* also appears to permit editing a disk if it is determined to be a DVD-RW disk.

(*Nakahara*, pg. 7, paras. 0133-0136.) If, however, the disk is determined to be a DVD-R 1 disk, *Nakahara* purports to check for available empty space before permitting further editing of the disk. (*Nakahara*, pg. 7, paras. 0137-0143.) *Ko* appears to disclose "a write protection method . . . for protecting data recorded by a user on a write-once or rewritable medium from unwanted overwriting or erasing." (*Ko*, pg. 1, para. 0003; *Office Action*, pg. 3.) In particular, *Ko* permits editing the disk only if the state of the "WRITE - INHIBIT HOLE" and the "WRITE PROTECTION FLAG" of the disk allow such editing. (*Ko*, Figs. 16, 17.) *Kikuchi* appears to disclose "a system which allows the user to create a menu corresponding to the recorded contents" when using a DVD recorder that can write data more than once on a recording medium, requiring the user to recreate the menu screen often. (*Kikuchi*, pg. 2, paras. 0021-0022, *Office Action* at pg. 4.)

The Office Action alleges that combining these teachings of *Nakahara*, *Ko*, and *Kikuchi* renders independent claims 1, 2, 9, and 22-25 obvious. But combining the teachings of *Nakahara*, *Ko*, and *Kikuchi* may at best disclose determining whether the disk type is DVD-RW or DVD-R 1 and permitting a user to create a menu corresponding to the recorded contents on the disk if it is not write protected, regardless of the disk's recording format and regardless of whether a menu is stored on the disk. But, *Nakahara*, *Ko*, or *Kikuchi* individually or in combination fail to teach or suggest "a disk-determination unit configured to determine that an inserted disk is a subject disk when the inserted disk is of a predetermined type and when the inserted disk stores a predetermined menu" as recited in claim 1 and similarly in claims 22 and 24.

Similarly, *Nakahara, Ko*, or *Kikuchi* individually or in combination fail to teach or suggest "a disk-determination unit configured to determine that an inserted disk is a subject disk when the inserted disk is of a DVD + RW type, when the inserted disk has a predetermined recording format, and when the inserted disk stores a predetermined menu" as recited in claim 2 and similarly in claims 9, 23, and 25. *Nakahara, Ko*, or *Kikuchi* individually or in combination also fail to teach or suggest "an additional recording-mode control unit configured to set a mode, for indicating whether additional recording onto the inserted disk is allowed, only when the inserted disk is determined to be the subject disk" as recited in claim 2.

Because *Nakahara, Ko*, or *Kikuchi*, individually or in combination, fail to disclose or suggest all the elements of amended independent claims 1, 2, 9, and 22-25 no prima facie case of obviousness has been established for these claims. Claims 3-10 depend from claim 2, and claims 10-19 depend from claim 9 and therefore are not obvious for at least the reasons stated.

The Office Action also alleges that combining the teachings of *Nakahara* and *Ko* renders claims 20 and 21 obvious. As discussed above, combining the teachings of *Nakahara* and *Ko* may at best disclose determining whether disk type is DVD-RW or DVD-R 1 and permitting editing of the disk if it is not write protected, regardless of the disc's recording format and regardless of whether a menu is stored on the disk. *Nakahara* and *Ko* individually or in combination fail to teach or suggest "a disk-determination unit configured to determine that an inserted disk is a subject disk when the inserted disk is a subject disk that is of a DVD + RW type, when the inserted disk

has a predetermined recording format, and when the inserted disk stores a predetermined menu" as recited in independent claim 20.

Therefore, because *Nakahara* and *Ko*, individually or in combination, fail to disclose or suggest all the elements of amended independent claim 20 no prima facie case of obviousness has been established for this claim. Claim 21 depends from claim 20 and therefore is also not obvious for at least the reasons stated.

Based on the foregoing reasons, Applicants respectfully request that the rejections of claims 1-25 under 35 U.S.C. § 103(a) be withdrawn.

### **III. CONCLUSION**

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the claims in condition for allowance. Applicant submits that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing, Applicant respectfully requests reconsideration of this application and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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